

REMARKS

Request for Reconsideration and Withdrawal of Restriction Requirement under 37 C.F.R. § 1.143

In the Office Action mailed April 30, 2004, the Examiner stated that newly submitted claims 21-28 are directed to an invention that is independent or distinct from the invention originally claimed because "the claims comprise a separate species that was not previously considered." Significantly, the Examiner presents no analysis of claims 21-28 or comparison of claims 1-7 to claims 21-28 in support of this contention.

Applicant respectfully disagrees that claims 21-28 are directed to an invention that is either independent **or** distinct from the invention recited in claims 1-7. MPEP § 802.01 defines the meaning of the words "independent" and "distinct" as used in the statutory provisions permitting restriction of examination to a single invention. Clearly, claims 1 and 21 are not "independent" as that term is defined in MPEP § 802.01. Both are claims directed to "a method of distributing electronic media for display at a multiplicity of remote locations." The claims are directed to one and the same inventive method and, in fact, use extremely similar language, though differing somewhat in form and structure, to recite the steps of the claimed method. Claims 1 and 21 are not related to each other as process and apparatus, process and product made; claims 1 and 21 are directed to the same invention. Indeed, apparatus claims 8-13 were previously withdrawn.

37 C.F.R. § 1.145 governs restriction of claims when "after an Office Action on an application, the Applicant presents claims directed to an invention distinct from and independent of the invention previously claimed." It should be noted that the language of Section 1.145 requires that the invention be both distinct from and independent of the invention previously claimed. Review of the form and language of claims 1 and 21 reveals that the inventions recited therein are neither independent nor distinct according to the definitions of those terms set out in MPEP § 802.01.

Claims 1 and 21 are very similar in scope and content. Applicant states that claims 1 and 21 are not independent or distinct and claims 1-7 and 21-28 are properly considered in the present application. Applicant respectfully requests withdrawal of the restriction requirement relating to claims 21-28 and requests substantive examination of claims 21-28.

Claim Rejections 35 U.S.C. § 112

Claims 1-7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to "particularly point out and distinctly claim the subject matter which applicant regards as the invention." The Examiner argues that the claim terms "electronic poster kits" and "posters" are not clear as to their meaning.

Legal Standard for Indefiniteness

The legal standard for indefiniteness was recently discussed in Metabolite Labs, Inc. v. Lab Corp. of America Holdings, 370 F.3d 1354 (Fed. Cir. 2004). The Federal Circuit stated that "The requirement to distinctly claim means that the claim must have a meaning discernable to one of ordinary skill in the art when construed according to correct principals" citing Union Pacific Resources Company v. Chesapeake Energy Corp., 236 F.3d 684, 692 (Fed. Cir. 2001). Further, "Only when a claim remains insolubly ambiguous without a discernable meaning after all reasonable attempts at construction must a court declare it indefinite." See Exxon Research and Engineering Company v. United States, 265 F.3d 1371, 1375 (Fed. Cir. 2001).

Claim language is construed according to its usage and context. The touchstone for discerning the usage of claim language is the understanding of those terms among artisans of ordinary skill in the relevant art at the time of invention. See Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1342, (Fed Cir. 2001). Normal rules of usage create a heavy presumption that claim terms carry their accustomed meaning in the relevant community at the relevant time. See CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366 (Fed. Cir. 2002). In most cases the best source for discerning the proper

context of claim terms is the patent specification wherein the patent Applicant describes the invention. Id.

Context of Claim Term "Poster" in Applicant's Specification

Applicant's specification begins with a description of the background of the invention. On page 1, line 9, Applicant introduces the word "posters" as "printed material" including photographs, art work, designs and/or slogans, and messages which pertain to a client's business. The term poster is used in the specification according to its ordinary and accustomed meaning. A poster is defined in Webster's Third New International Dictionary as "a bill or placard intended to be posted in a public place, specifically, one that is decorative or pictorial." Thus, in the context of the description a poster would be understood by one of skill in the art as being a bill or a placard intended to be posted in a public place. Indeed, the posters described in the background of the invention are a well-known aspect of work life in many environments. Posters relating to safety, quality, teamwork, morale, etc. are commonly displayed in manufacturing, educational and other institutions. Applicant further describes how such posters were traditionally generated. Traditionally, posters were generated by graphic designers, by hand or on a computer design system, printed and forwarded to the client where they can be posted by mounting to a vertical surface for display.

The Meaning of "Poster" is Clear

Thus, the meaning of the term "poster" and its plural form "posters" are clear and would be well understood by one of skill in the art from the description of the invention in Applicant's specification as filed. The claim terms "poster" and "posters" benefit from their "ordinary and accustomed meaning." Nothing in Applicant's specification indicates a clear intent to remove the claim terms from their ordinary and accustomed meaning.

Context of Claim term "Electronic Poster Kit" in Applicant's Specification

In the Summary of the Invention, Applicant describes the advantages of transforming what was a printed and physically delivered business communication in the form of a paper or cardboard "poster" into electronic form. The content of the poster is the same, i.e., graphics, images and messages intended to convey a business communication, but it is now in electronic form so that it may be stored, manipulated, delivered and displayed electronically. The traditional poster becomes an "electronic poster." One of skill in the art would understand an "electronic poster" to be the traditional poster in electronic form.

On page 4, lines 3-9, Applicant describes the process of "generating a poster kit containing at least one electronic poster." Claim 1 as originally filed recites "creating a plurality of electronic poster kits each containing a plurality of posters." It is clear from the context and usage of the term "electronic poster kit" that this term refers to a collection of one or more posters in electronic form. Applicant's specification gives further details as to how the posters are organized into poster kits and stored on a web site for access by a user.

At the time of filing of Applicant's specification, there was a strong tradition of adding the word "electronic" to existing terms to describe a newly developed electronic form. One prominent example is e-mail, which is of course an abbreviated form of "electronic mail". One of skill in the art is very familiar with this practice and would have no problem assessing the meaning of the claim term "electronic poster kit".

The Examiner previously cited an article in the Journal of Geography in Higher Education by Whalley et al. (hereinafter Whalley) as being relevant to Applicant's invention. Whalley discloses a familiarity of those of skill in the with the terminology "electronic poster". The understanding of the term "electronic poster" in Whalley is consistent with the ordinary usage of the term poster and its electronic form as suggested in the discussion above. An electronic poster as described in Whalley is a combination of text and images used to illustrate a point or teach a lesson and intended

for display in a public place. This definition of "electronic poster" is consistent with the definition of the term "electronic poster" based on the ordinary and accustomed meaning of the constituent terms. Further, this definition of "electronic poster" is consistent with the meaning advocated by Applicant above. Finally, this definition of "electronic poster" is distinct from a pop-up window or web page in the context of computers and the Internet.

The Meaning of "Electronic Poster Kit" is Clear

The meaning of "electronic poster kit" is clear from its context in Applicant's specification and the commonly understood meaning of the constituent words. There is no clear disavowal of the commonly understood meaning of these claim terms. Further, the addition of the term "electronic" to pre-existing terminology is a well-established practice in modern usage. One of ordinary skill in the art would have no problem establishing the meaning of the claim term "electronic poster kit".

Withdrawal of the 35 USC §112 Rejection is Requested

In sum, one of skill in the art would easily understand the scope and meaning of the terms "electronic poster kits" and "posters" as used in claims 1-7 and 21-28. Applicant respectfully requests withdrawal of the Examiner's 35 U.S.C. § 112 rejection of claims 1-7.

Claim Rejections - 35 U.S.C. § 103

Claims 1-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,725,203 to Seet et al. (hereinafter Seet). Seet discloses an electronic advertising method and system for an Internet browser with a book-like page based flipping interface. In the context of the page-based flipping interface, electronic advertisements are presented in the sequence of pages of an electronic book, as a reader pages through the book. Seet also describes an advertisement matching/delivery system in which the subject matter of the books read by the user are used to direct relevant advertisements to the user. Significantly, the terms electronic poster, poster or electronic poster kit do not appear in Seet.

Figures 5A and 5B cited by the Examiner illustrate an exemplary advertisement request (pull) interface 501 and an exemplary advertiser initiated (push) interface 531. These are interactive screens on which an advertiser enters relevant information in fields 506-510 and 536-540 to tailor the appearance, location and duration of an advertisement in the advertising method. After completion of the relevant fields of Figures 5A and 5B the advertiser presses go which initiates an advertising search and matching process according to the advertising process of Seet. Significantly, the screens identified by the Examiner as suggesting Applicant's invention are not intended for public display, do not convey a business communication and cannot be considered an "electronic poster".

Contrary to the assertions of the Examiner, Seet does not disclose, teach or suggest electronic posters gathered into electronic poster kits. The user interface screens shown in Figures 5A and 5B include fields to be filled in by an advertiser to designate the size, location and frequency desired for their advertisements. Merely designating such desired attributes does not necessarily mean the requested advertisement will actually take place. According to the description of Seet the advertisement will occur only after a search and matching process according to the disclosed method.

Claims 1-7

Claim 1 recites in pertinent part as follows:

- (a) creating a plurality of electronic poster kits each containing a plurality of posters;
- (b) posting said electronic poster kits on a web site;
- (c) permitting access by a subscriber to said web site over the Internet to view a poster kit;
- (d) selecting by the subscriber from a remote location a set of posters from said web site;
- (e) customizing by the subscriber said selected set of posters from said remote location by transmitting data over the Internet;
- (f) transmitting said customized selected set of posters over the Internet to said remote location; and

- (g) displaying said customized selected set of posters on a screen designated by the subscriber.

Claim 1 recites specific method steps, particularly steps c-e and g, where a subscriber is permitted access to a website to select a set of posters, customize the selected set of posters and designate a screen for display of the selected customized posters. Seet does not disclose, teach or suggest at least steps c-e and g of claim 1. Claim 1 is patentable over the disclosure of Seet.

Claims 2-7 depend directly or indirectly from claim 1 and are patentable for at least the reasons stated in support of claim 1.

Claims 4 and 5 recite particular default actions according to the claimed method that are not disclosed, taught or suggested by Seet. Claims 4 and 5 are patentable for at least this additional reason.

Claims 21-28

Claim 21 recites in pertinent part as follows:

- (a) creating electronic posters;
- (b) posting said electronic posters on a web site;
- (c) permitting access by a subscriber to said web site from a remote location, said access permitting the subscriber to:
 - (1) view a plurality of said electronic posters;
 - (2) create a customized set of electronic posters by selecting one or more of said electronic posters from said plurality of electronic posters; and
 - (3) order delivery of said customized set of electronic posters over the Internet to a subscriber-designated remote location;
- (d) delivering said customized set of electronic posters over the Internet to said subscriber-designated remote location; and
- (e) displaying said customized set of electronic posters on a screen selected by said subscriber.

Claim 21 recites steps c through e involving subscriber access to a website containing electronic posters, creating a customized set of electronic posters, ordering delivery of the customized set of electronic posters to a subscriber designated remote location and displaying the customized set of electronic

posters on a screen designated by the subscriber. These steps are not disclosed, taught or suggested by Seet. Claim 21 is patentable over Seet for at least these reasons.

Claims 22-28 depend directly or indirectly from claim 21 and are patentable for at least the reasons stated in support of claim 21.

Claim 22 recites in pertinent part "receiving criteria for creation of said electronic posters from the subscriber; and organizing said electronic posters into electronic poster kits according to said criteria." Seet does not disclose, teach or suggest the creation of electronic posters and therefore cannot disclose, teach or suggest organizing such electronic posters according to criteria received from a subscriber. Claim 22 is patentable over Seet for at least this additional reason.

Claim 23 recites in pertinent part "limiting access by said identified subscriber to said electronic poster kits organized according to criteria gathered from said identified subscriber." Seet does not disclose, teach or suggest electronic posters or organizing electronic posters into electronic poster kits. Further, Seet does not disclose, teach or suggest limiting access by an identified subscriber as recited in claim 23. Claim 23 is patentable for at least this additional reason.

Claims 24 and 25 recite default steps which are taken by the method of claim 21 upon nonoccurrence of particular actions by the subscriber. Seet does not disclose, teach or suggest a subscriber based media distribution method as recited in claim 21 and certainly does not disclose, teach or suggest a subscriber based media distribution method including default steps as recited in claims 24 and 25. Claims 24 and 25 are patentable for at least these additional reasons

Appl. No. 09/758,833
Amdt. dated July 22, 2004
Reply to Office Action of April 30, 2004

For all the foregoing reasons, Applicant respectfully requests allowance of claims 1-7 and 21-28.

Respectfully submitted,

FRANK KENNA, III et al



Thomas J. Menard
Registration No. 42,877
Alix, Yale & Ristas, LLP
Attorney for Applicant

Date: July 22, 2004
750 Main Street
Hartford, CT 06103-2721
Our Ref: MARCO/101/US
TJM:io

\\PATLAW5\C-PATLAW5\AYR saved docs\Filing Docs\MARCO\marco.101.us.response.07-04.doc